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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/630,982 | 07/31/2003 | James Dunman | 29953.184828 | 1857 |
| 26694 | 7590 | 11/21/2005 | EXAMINER | |
| VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998 | | | PARKER, FREDERICK JOHN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1762 | |

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/630,982 | DUNMAN, JAMES | |
| | Examiner | Art Unit | |
| | Frederick J. Parker | 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on RCE of 10/6/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/6/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-06-05 has been entered.

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections of the previous Office action.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17-20 include limitations that shields do not hold a threaded engagement portion of a finish of the containers for which Applicants now cite figure 1 as support, and argue “shield 10 does not engage or hold the threaded portion of the container 18”.

The Examiner provides an exploded view of figure 1 as attached and notes that the lower section of the upper shield (referred to by the arrow) contacts and interlocks (i.e. “engages”) AND imposes “restraint upon or limit(s) in motion or action” (“hold”, see attached Dictionary

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definition) on the container 18 by virtue of the overlapping contract of the shield shoulder and the top portion of the threaded portion of container 18.

Since Applicants' sole support is figure 1 and the specification fails to supply further meaning of the limitation, the Examiner maintains the New Matter rejection of claims 17-20.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-4,6,8-12,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620.

Carl teaches a method of coating threaded glass containers, in which the threaded closure portion of the container 12 contacts a threaded masking chuck 18 of body member 10 on support means 21, which in turn is part of a conveyor means 25. The threaded masking means is a "shield" to prevent coating of threaded portions of the container. The conveyor moves the

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containers to a coating area where they are coated by spray gun 22(without further limitation) or other coating means. See col. 3, 50 to col. 4, 26. Body member 10 may be fabricated from plastic materials such as HD PE, "Bakelite", etc without limitation as to forming method. Hence it is the Examiner's position that it would have been obvious to form such articles by known and conventional forming means, such as injection molding, because the process is conventionally used to form complex plastic polymer parts. The reference also teaches on col. 1, 47-51 that containers of plastic, ceramic, etc in addition to glass are conventionally coated by spraying or other means. However, the reference does not explicitly state the material making up the masking/ shielding means is the same as, and made from scrap of, the containers even though it is apparent from the reference that both containers and masking/ shielding means can be made of a polymeric plastic.

White also teaches the concept of coating certain portions of a container while shielding other portions from the coating material. Shielding means 114 are taught, without limitation of the material from which it is made. In col. 1, 13-22, it is specifically taught that the beverage industry is substituting polymeric plastics, and particularly the polyester polyethylene terephthalate (PET), for containers in place of glass or metal. It further teaches that containers must be recyclable due to state and federal mandates, and that PET material is recyclable (col. 1, 63-68; etc). The recycling of scrap material from a PET container-making operation would therefore have been an obvious variation given the teachings of White because there is simply no reason to expect that formed containers and scrap from making the same formed containers would have any difference in their ability to be recycled and reformed, absent a clear and convincing showing to the contrary. Hence it would have been obvious to substitute the glass

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container of Carl with an equivalent polymer plastic container to follow industry trends and comply with recycling regulations as taught by White. Carl is not limited to specific engineering polymer materials from which the masking body members are formed, and White teaches that formable/ recyclable engineering polymeric plastics such as PET are used to make threaded containers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Carl et al on plastic instead of glass container to follow the industry trends disclosed by White, and further using a polymeric masking body member of recycled scrap PET from the plastic container making process because White also discloses that PET can be recycled to be re-formed into articles. Further, the use of production scrap to make the polymeric masking body would have provided an opportunity to re-form container scrap into a useful product used in container production, resulting in apparent economic benefits.

As to claims 11-12, it would have been obvious to the skilled artisan to perform maintenance on the conveyor/ production line at an interval commensurate with the use of the production line to remove and dispose of broken or mal-functioning parts, including the masking/ shielding means.

2. Claims 5,7,13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620 and further in view of the Admitted Prior Art (APA).

Carl et al and White are cited for the same reasons previously discussed, which are incorporated herein. Oxygen barrier coatings are not disclosed. However the APA discloses it is known to electrostatically apply oxygen barrier coats to plastic polymer/ PET containers, except at threaded portions, to prevent the adverse effects of oxygen migration through the walls of the

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containers. Since electrostatic coating encompasses electrostatic spraying, and Carl et al teaches to apply coatings to containers by “spraying”, the use of electrostatic spraying would have been an obvious variation of the teachings of Carl et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Carl et al in view of White by electrostatically spraying oxygen barrier coatings to container surfaces to prevent the adverse effects of oxygen migration through the walls of the containers.

Response to Arguments

Applicants argue there is “no suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art” to combine the references. This argument is baseless. Recycling of waste or consumer-used plastics is pervasive in our culture to reduce landfill waste and enhance cost-effectiveness of our plastic resources. This is known and apparent to at least those of ordinary skill. Applicants are reminded that the criteria of *Graham v. Deere* includes “Resolving the level of ordinary skill in the pertinent art” which the Examiner has done with considerable thought in the rejection. Furthermore, Applicants appear to have ignored White col. 1, 63 to col. 2, 2 and col. 4, 13-15 which recognizes the trend towards recycling as far back as 1987. It is the Examiner’s position that recycled plastic ware or scrap/waste from the process of making said plastic-ware are identical in properties and composition, and therefore equally recyclable, absent a clear and convincing showing of unexpected or synergistic results to the contrary. To further support the point, the Examiner cites US 5712009 to illustrate the state of the art, wherein col. 5, 28-29 equates “post consumer recycled...resin, process trim, and off ware scrap” (recycling is also discussed in col. 1, 11-60). Applicants simply fail to convincingly set forth why a recycle article made from process waste

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scrap would be different from one made from post consumer or other plastic recycle so well known in manufacturing. Thus the argument set forth by Applicants is not persuasive.

As to the second argument, the above explanations are equally relevant and incorporated herein. A part made from scrap of a material would reasonably be expected to provide equivalent outcomes as products made from the material from which the scraps originated, if recycled.

The means of the prior art holds the articles on the chucks by "friction fit" given the meaning of Applicants as read in view of the spec. page 3, 1-2.

The Examiner is not convinced the shields of Carl are permanent/ never to be removed for maintenance or cleaning during shutdown. It is unreasonable to expect that a faulty or unusable part on a conveyor process is left, and can ultimately cause disablement of the process. Clearly process line maintenance and removal of unusable or broken parts is well within the level of ordinary skill.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner is unconvinced by the hindsight argument given the teachings of the references and the way the prior art has been crafted to provide a logical rejection.

Conclusion

Applicants arguments are not convincing and appear to ignore the logically reasoned basis for establishing the rejections under 35 USC 103. Applicants have failed to provide any reasoning or evidence why manufacturing scrap would provide a different recycled plastic product with unexpected/ patentable results than recycle of the manufactured post-consumer product itself. Accordingly all rejections are maintained.


3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5712009 illustrates the state of the art of recycling plastic including the equivalence of post-consumer recycled plastic, plastic process trim, and plastic scrap.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp

